

REMARKS

By this Amendment, claims 6, 10 and 14 were amended, claims 16-26 were added, and claims 5, 7-9, 11-13, and 15 were deleted. No new matter has been added by these amendments. As a result, claims 1-4, 6, 10, 14 and 16-26 are pending in the case.

In the Office Action dated November 16, 2006, the Examiner stated that claims 1-4 are allowable, but rejected claims 5-15 as being an improper recapture of the broadened claimed subject matter surrendered in the original application for U.S. Patent No. 6,305,621, upon which the present reissue application is based. The Examiner also rejected claims 5 and 6 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,674,686 to Trapp (“Trapp”). Claims 14 and 15 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,697,742 to Schnipke (“Schnipke”). The Examiner rejected claims 7-11 and 13 under 35 U.S.C. § 103(a) as being unpatentable over Trapp in view of U.S. Patent No. 1,665,810 to Gillick (“Gillick”). Claim 12 was also rejected under 35 U.S.C. § 103(a) as being unpatentable over Trapp in view of Gillick as applied to claims 7-11 and 13 above, and further in view of Schnipke.

Regarding the recapture rejection, Applicants have cancelled claims 5, 7-9, 11-13 and 15, added new claims 16-26, and amended claims 6, 10 and 14. Applicants submit that these amendments avoid the recapture rule because they include additional limitations that materially narrow the claims in other respects. As the Examiner is likely aware, recapture is a three-part inquiry: “(1) first, we determine whether, and in what respect, the reissue claims are broader in scope than the original patent claims; (2) next, we determine whether the broader aspects of the reissue claims relate to subject matter surrendered in the original prosecution; and (3) finally, we determine whether the reissue claims were materially narrowed in other respects, so that the claims may not have been enlarged, and hence avoid the recapture rule.” *North American Container, Inc. v. Plastipak Packaging, Inc.*, 415 F.3d 1335, 1349, 75 USPQ2d (BNA) 1545, 1556 (Fed. Cir. 2005).

Applicants’ amended claims fall under number 3 of this test and are, therefore, outside of the recapture rule. In particular, newly added independent claims 16 and 23 both require “a plurality of spiked folding legs; a valve handle; and, a pivoting fluid conduit joint.” These additional limitations materially narrow the claims in a way that is unrelated to the recapture

problem pointed out by the Examiner, thereby making the recapture rule inapplicable. These amendments find support in the specification at Column 3, lines 22-26 and in Figure 1 and are important to the operation of the invention. The spiked folding legs “provide a broad base on which the monitor 20 reaction forces can be supported for stability.” (Specification, Col. 3, lines 23-25). The valve handle “provides easy operation and direct control by the operator.” (Specification, Col. 3, lines 25-26). Therefore, Applicants respectfully request that the recapture rejection under 35 U.S.C. 251 be withdrawn.

Regarding the 102 rejection over Trapp, Applicants point out that Trapp does not disclose “a pivoting fluid conduit joint,” as required by new independent claims 16 and 23. The Examiner maintains that Trapp discloses “a hose 72 at a pivoting inlet joint 72 pivotable about a horizontal axis.” (Office Action, paragraph 3). However, item 72 of Trapp is not a pivoting inlet joint. Rather, item 72 of Trapp is merely a conduit – it is not a pivotable conduit joint. The specification of Trapp explains: “Mount 86 includes a conduit 72 which is in flow communication with inlet 94. A swivel bearing 82 extends about conduit 72. Conduit 72 and bearing 82 of mount 86 is like conduit 72 and bearing 82 of mount 10 and includes the same components.” (Trapp, Col. 3, lines 49-54). Trapp explains that: “swivel bearing 82 extends about mount housing 74 and is rotatable about the housing through bearings 84 which ride within grooves 78, 80. Swivel bearing 82 includes a bevelled upper end 88 and a lower flat edge or shoulder 89.” (Trapp, Col. 3, lines 3-8). This is also shown in Figure 3 of Trapp.

The swivel joint of Trapp differs structurally from the joint claimed by Applicants. As pointed out in Applicants’ specification, “Ball and socket swivels have only a few parts and are simple to manufacture and maintain as compared to swivels that use ball bearings, for example. Ball and socket swivels typically have very direct flow passages that can result in less pressure loss in the firefighting fluid flowing therethrough.” (Specification, Col. 1, lines 22-27).

Moreover, Trapp does not disclose “a valve handle” as part of the monitor housing. For at least these reasons, Trapp cannot anticipate the claims as amended.

Likewise, Schnipke cannot anticipate the claims as amended. For example, Schnipke does not disclose a monitor housing with “a plurality of spiked folding legs” and “a valve handle.”

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Regarding the 103(a) rejections, none of the cited references, alone or in combination, teach or suggest Applicants' invention as claimed in the amended claims. Quite importantly, none of the cited references teach or suggest the use of "a valve handle" as part of the monitor housing. Therefore, all claims patentably distinguish over the cited references in combination.

The Examiner and Commissioner are hereby authorized to charge any additional fees associated with this Response or refund any overpayments associated with this Response to our deposit account, Deposit Account No. 23-0280.

In view of the above, all pending claims are believed to be in condition for allowance; an action to this end is earnestly requested. If it would expedite the progress of this Application through the examination process, the Examiner is authorized to call the undersigned attorney.

Respectfully submitted,

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By: *Daniel N. Christus*

Daniel N. Christus, Reg. No. 29,626
Wallenstein Wagner & Rockey, Ltd.
311 South Wacker Drive, 53rd Floor
Chicago, Illinois 60606-6630
312.554.3300

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I hereby certify that this correspondence is, on the date shown below, being deposited with the United States Postal Service, with first class postage prepaid, in an envelope addressed to: Mail Stop Amendment, Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on February 16, 2006.

Amy Crout Ziegler
Amy Crout Ziegler/240002.1